Mohammad Mubde Absi & Ors v Hyat Collections Sdn Bhd & Ors

HIGH COURT (KUALA LUMPUR) — SUIT NO WA-22IP-15–04 OF 2017
WONG KIAN KHEONG J
30 APRIL 2019

Patents — Infringement — Validity of patent — Plaintiffs as co-owners of patent of instant hijabs brought action against defendants for patent infringement — Defendants filed counterclaim to invalidate patent — Notional person ordinarily skilled in the art (POSITA) — Whether plaintiffs' hijab was an 'invention' — Whether plaintiffs' hijab was 'new' — Whether plaintiffs' hijab involved 'inventive step' — Whether plaintiffs' patent complied with s 23 of the Patents Act 1983 read with regs 12(1)(c), (1)(f) and 13(1) of the Patents Regulations 1986 — Whether defendants' sales of defendants' hijabs infringed plaintiffs' patent under ss 36(1)(a), (2), (3)(a)(i) & 58 of the Patents Act 1983 — Patents Act 1983 ss 11, 12(1), 13(1), 14(1), 15(1), 16, 23, 36(1)(a), (2), (3)(a)(i), 56 & 58

The plaintiffs were the co-owners of Patent No MY-153705-A ('Patent 705') in relation to an instant 'hijab'. In the present case, the plaintiff alleged that the defendants had infringed Patent 705 by distributing and selling 'Product Hyat' hijabs ('Hyat Hijabs'). In this regard, there were five claims in Patent 705 whereby claim 1 consisted of the essential integers. The defendants had counterclaimed to invalidate Patent 705. The issues for consideration were: (a) who was the notional person ordinarily skilled in the art ('POSITA')? — in relation to this issue, the plaintiffs had called SP2 as the POSITA whereas the defendants had called SD1 as the POSITA; (b) whether the plaintiffs' ready-to-wear and pinless hijab ('Bokitta Hijab') an 'invention' under s 12(1) of the Patents Act 1983 ('the PA'); (c) whether Bokitta Hijab was 'new' within the meaning of s 14(1) of the PA; (d) whether Bokitta Hijab involved an 'inventive step' as understood in s 15(1) of the PA; (e) whether Patent 705 had complied with s 23 of the PA read with regs 12(1)(c), (1)(f) and 13(1) of the Patents Regulations 1986 ('the PR'); and (f) if Patent 705 was valid, whether the defendants' sales of Hyat Hijabs had infringed Patent 705 under ss 36(1)(a), (2), (3)(a)(i) and 58 of the PA.

Held, dismissing the counterclaim with costs, and allowing the plaintiffs' action with costs:

(1) A POSITA for Patent 705 was a notional person who: (a) was ordinarily skilled with regard to hijabs, including ready-to-wear and pinless hijabs;

and (b) should have qualification, knowledge and/or experience in the fashion industry pertaining to hijabs, especially ready-to-wear and pinless hijabs. Based on the evidence, the court found that SP2 was a POSITA with respect to the invention regarding hijabs in Patent 705 and the court was not able to accept SD1 as POSITA. As such, the court attached weight to SP2's testimony and the court did not attach any weight on SD1's expert opinion (see paras 20–22 & 24).

(2) It was clear that the patentability of a ready-to-wear and pinless hijab was not barred by s 13(1)(a)–(1)(d) of the PA. Further, a ready-to-wear and pinless hijab was an 'invention' within the literal meaning of s 12(1) of the PA. This was because, based on 'The Shorter Oxford English Dictionary' — Volume 2, the online 'Meriam-Webster Dictionary', and the online 'Collins English Dictionary', the term 'technology' in s 12(1) of the PA encompassed ideas regarding hijabs. In addition, Patent 705 constituted an 'idea' of the plaintiffs which permitted in practice the solution to the three problems associated with the traditional hijabs as understood in s 12(1) of the PA. Alternatively, Patent 705 was an 'invention' under s 12(1) of the PA when s 12(1) was construed in a purposive manner. Such a decision supported the purpose of PA which was to protect ideas of inventors. Based on the above findings, the defendants had failed to invalidate Patent 705 pursuant to ss 56(1) and (2)(a) of the PA on the ground that Bokitta Hijab was not an 'invention' under s 12(1) of the PA (see paras 30 & 36–38).

(3) The court found that the invention of Bokitta Hijab in Patent 705 was novel as understood in ss 11 and 14(1) of the PA based on the following evidence and reasons: (a) there was no single document before the priority date ('prior art') which disclosed all the essential integers; (b) there was no evidence that a POSITA regarding Patent 705 was able to design Bokitta Hijab (the invention claimed in Patent 705) based on the single piece of prior art which had disclosed all the essential integers; and (c) applying the 'reverse infringement test', there was no proof that the prior art constituted an infringement of Patent 705. Based on the above evidence and reasons, the defendants had failed to discharge the onus to satisfy the court that Patent 705 should be invalidated on the ground of lack of novelty under s 56(1) and (2)(a) of the PA (see paras 45–46).

(4) Applying the *Windsurfing*'s test as explained by the Federal Court in *Spind Malaysia Sdn Bhd v Justrade Marketing Sdn Bhd & Ors* [2018] 4 MLJ 34, the court was satisfied that the invention in Patent 705 involved an inventive step within the meaning of ss 11 and 15 of the PA. The defendants had failed to discharge the burden under s 56(1) and (2)(a) of the PA to prove that the invention in Patent 705 lacked an inventive step as required by ss 11 and 15 of the PA. In addition, the court further found

that the invention in Patent 705 complied with s 23 of the PA read with regs 12(1)(c) and 13(1) of the PR and was 'industrially applicable' pursuant to s 16 of the PA (see paras 49–50, 52, 56 & 64).

(5) SP2, the POSITA for Patent 705 had examined the first and second Hyat Hijabs being the subject matter of two trap purchases. According to SP2's expert opinion, the first and second Hyat Hijabs had all the essential integers (claim 1). Accordingly, the first and second Hyat Hijabs had breached claim 1 based on the essential integers test. In view of the trap purchases concerning the first and second Hyat Hijabs, the court was satisfied that the plaintiffs had proven on a balance of probabilities that the defendants had sold Hyat Hijabs in contravention of Patent 705 within the meaning of ss 36(1)(a), (2), (3)(a)(i) and 58 of the PA (see paras 60 & 63).

(6) Applying *Improver*'s test, based on the expert view of SP2, the court found as a fact the following (a) the features of Hyat Hijab which were different from essential integers (claim 1), did not have a material effect on the way the invention in claim 1 worked ('immaterial variants'); (b) the immaterial variants would have been obvious to SP2 on the date of publication of Patent 705; and (c) SP2 would not have understood from the language of claim 1 that the plaintiffs intended that strict compliance with the primary meaning of claim 1 was an essential requirement of the invention in claim 1. Based on the above findings, the court was satisfied that the first and second Hyat Hijabs had breached claim 1 (see para 62).

(7) An application of *Actavis*' test in this case clearly showed an infringement of Patent 705 as followed: (a) relying on the expert testimony of SP2, Hyat Hijab achieved substantially the same result in substantially the same way as the invention in claim 1, namely Hyat Hijab had the same inventive concept as Bokitta Hijab; (b) it was obvious to SP2, reading claim 1 on the priority date that Hyat Hijab achieved substantially the same result as the invention in claim 1 in substantially the same way as the invention in claim 1; and (c) SP2 would not have concluded that the plaintiffs intended that strict compliance with the literal meaning of claim 1 was an essential requirement of the invention in claim 1 (see para 62).

[Bahasa Malaysia summary

Plaintif-plaintif adalah pemilik bersama Paten No MY-153705-A ('Paten 705') berkaitan dengan 'hijab' segera. Dalam kes ini, plaintif mendakwa bahawa defendan telah melanggar Paten 705 dengan mengedar dan menjual hijab 'Product Hyat' ('Hyat Hijabs'). Dalam hal ini, terdapat lima tuntutan dalam Paten 705 di mana tuntutan 1 merupakan ciri-ciri penting. Defendan membuat tuntutan balas untuk membatalkan Paten 705. Perkara-perkara yang

perlu dipertimbangkan adalah: (a) siapa 'notional person ordinarily skilled in the art' ('POSITA')? — berkaitan dengan isu ini, plaintif-plaintif telah memanggil SP2 sebagai POSITA manakala defendan-defendan telah memanggil SD1 sebagai POSITA; (b) sama ada tudung sedia untuk di pakai dan tanpa pin plaintif-plaintif ('Bokitta Hijab') adalah 'ciptaan' di bawah s 12(1) Akta Paten 1983 ('AP'); (c) sama ada Bokitta Hijab 'baru' dalam maksud s 14(1) AP; (d) sama ada Bokitta Hijab melibatkan 'langkah inventif' seperti yang difahami dalam s 15(1) AP; (e) sama ada Paten 705 telah mematuhi s 23 AP dibaca dengan peraturan 12(1)(c), (1)(f) dan 13(1) Peraturan Paten 1986 ('PP'); dan (f) jika Paten 705 sah, sama ada penjualan Hyat Hijabs oleh defendan-defendan telah melanggar Paten 705 di bawah ss 36(1)(a), (2), (3)(a)(i) dan 58 AP.

Diputuskan, menolak tuntutan balas dengan kos dan membenarkan tuntutan plaintif-plaintif dengan kos:

(1) POSITA untuk Paten 705 adalah 'notional person' yang (a) biasanya mahir berkaitan dengan tudung, termasuk tudung sedia untuk di pakai dan tanpa pin; dan (b) harus mempunyai kelayakan, pengetahuan dan/atau pengalaman dalam industri fesyen yang berkaitan dengan tudung, terutama tudung sedia untuk di pakai dan tanpa pin. Berdasarkan keterangan, mahkamah mendapati SP2 adalah POSITA berkenaan dengan ciptaan tudung di dalam Paten 705 dan mahkamah tidak dapat menerima SD1 sebagai POSITA. Oleh itu, mahkamah memberikan pemberatan terhadap keterangan SP2 dan mahkamah tidak memberikan pemberatan atas pendapat pakar SD1 (lihat perenggan 20–22 & 24).

(2) Sudah jelas bahawa hak paten tudung sedia untuk di pakai dan tanpa pin tidak dilarang oleh s 13(1)(a) hingga (d) AP. Selanjutnya, tudung sedia untuk di pakai dan tanpa pin adalah 'ciptaan' dalam maksud harfiah s 12(1) AP. Ini kerana, berdasarkan 'The Shorter Oxford English Dictionary' — Volume 2, 'Meriam-Webster Dictionary' dalam talian, dan 'Collins English Dictionary' dalam talian, istilah 'teknologi' dalam s 12(1) AP merangkumi idea mengenai tudung. Sebagai tambahan, Paten 705 merupakan 'idea' plaintif-plaintif yang secara praktiknya membenarkan penyelesaian terhadap tiga masalah yang berkaitan dengan tudung tradisional seperti yang difahami dalam s 12(1) AP. Sebagai alternatif, Paten 705 adalah 'ciptaan' di bawah s 12(1) AP apabila s 12(1) ditafsirkan berdasarkan tujuan. Keputusan tersebut menyokong tujuan AP yang bertujuan melindungi idea pencipta. Berdasarkan dapatan-dapatan di atas, defendan-defendan gagal membatalkan Paten 705 berdasarkan ss 56(1) dan (2)(a) AP dengan alasan bahawa Bokitta Hijab bukan 'ciptaan' di bawah s 12(1) AP (lihat perenggan 30 & 36–38).

(3) Mahkamah mendapati bahawa ciptaan Bokitta Hijab dalam Paten 705 adalah novel seperti yang difahami dalam ss 11 dan 14(1) AP berdasarkan bukti dan alasan berikut: (a) tidak ada satu pun dokumen sebelum tarikh utama ('seni terdahulu') yang mendedahkan semua ciri-ciri penting; (b) tidak ada bukti bahawa POSITA berkenaan dengan Paten 705 dapat membuat rekaan Bokitta Hijab (ciptaan yang dituntut dalam Paten 705) berdasarkan satu karya seni terdahulu yang telah mendedahkan semua ciri-ciri penting; dan (c) mengguna pakai 'reverse infringement test', tidak ada bukti bahawa seni terdahulu merupakan pelanggaran Paten 705. Berdasarkan keterangan dan alasan di atas, defendan-defendan telah gagal melepaskan tanggungjawab untuk memuaskan mahkamah bahawa Paten 705 harus dibatalkan kerana tidak baru di bawah s 56(1) dan (2)(a) AP (lihat perenggan 45–46).

(4) Mengaplikasikan Ujian 'Windsurfing' seperti yang dijelaskan oleh Mahkamah Persekutuan dalam *Spind Malaysia Sdn Bhd v Justrade Marketing Sdn Bhd & Ors* [2018] 4 MLJ 34, mahkamah berpuas hati bahawa ciptaan dalam Paten 705 melibatkan langkah inventif dalam erti ss 11 dan 15 AP. Defendan-defendan telah gagal melepaskan beban di bawah s 56(1) dan (2)(a) AP untuk membuktikan bahawa ciptaan dalam Paten 705 tidak memiliki langkah inventif seperti yang disyaratkan oleh ss 11 dan 15 AP. Sebagai tambahan, mahkamah selanjutnya mendapati bahawa ciptaan dalam Paten 705 mematuhi s 23 AP dibaca dengan peraturan 12(1)(c) dan 13(1) PP dan 'industrially applicable' berdasarkan s 16 AP (lihat perenggan 49–50, 52, 56 & 64).

(5) SP2, POSITA untuk Paten 705 telah memeriksa Hyat Hijab pertama dan kedua yang menjadi subjek kepada dua pembelian perangkap. Menurut pendapat pakar SP2, Hyat Hijab pertama dan kedua mempunyai semua ciri-ciri penting (tuntutan 1). Oleh itu, Hyat Hijab pertama dan kedua telah melanggar tuntutan 1 berdasarkan 'Essential Integers Test'. Berdasarkan pembelian perangkap berkenaan dengan Hyat Hijab pertama dan kedua, mahkamah berpuas hati bahawa plaintif-plaintif telah membuktikan di atas imbangan kebarangkalian bahawa defendan-defendan telah menjual Hyat Hijab bertentangan dengan Paten 705 dalam erti ss 36(1)(a), (2), (3)(a)(i) dan 58 AP (lihat perenggan 60 & 63).

(6) Dengan mengguna pakai '*Improver*'s test', berdasarkan pandangan pakar SP2, mahkamah membuat dapatan fakta seperti berikut (a) ciri-ciri Hyat Hijab yang berbeza dari ciri-ciri penting (tuntutan 1), tidak memberi kesan material terhadap cara penciptaan dalam tuntutan 1 berjalan ('varian tidak material'); (b) varian tidak material tersebut sepatutnya jelas bagi SP2 pada tarikh penerbitan Paten 705; dan (c) SP2 tidak akan memahami dari ayat tuntutan 1 bahawa plaintif-plaintif bermaksud bahawa pematuhan ketat terhadap maksud utama tuntutan 1 adalah

syarat penting penciptaan dalam tuntutan 1. Berdasarkan dapatan-dapatan di atas, mahkamah berpuas hati bahawa Hyat Hijab pertama dan kedua telah melanggar tuntutan 1 (lihat perenggan 62).

(7) Penggunaan '*Actavis*' test' dalam kes ini dengan jelas menunjukkan pelanggaran Paten 705 seperti berikut: (a) bergantung kepada keterangan pakar SP2, Hyat Hijab mencapai hasil yang hampir sama dengan cara yang sama dengan ciptaan dalam tuntutan 1 , iaitu Hyat Hijab mempunyai konsep ciptaan yang sama dengan Bokitta Hijab; (b) jelas bagi SP2, apabila membaca tuntutan 1 pada tarikh utama bahawa Hyat Hijab mencapai hasil yang hampir sama dengan ciptaan dalam tuntutan 1 dengan cara yang hampir sama dengan ciptaan dalam tuntutan 1; dan (c) SP2 tidak akan menyimpulkan bahawa plaintif-plaintif bermaksud bahawa pematuhan ketat terhadap maksud harfiah tuntutan 1 adalah syarat penting bagi penciptaan dalam tuntutan 1 (lihat perenggan 62).]

Cases referred to

Actavis UK Ltd & Ors v Eli Lilly and Co, and other appeals [2018] 1 All ER 171, SC (folld)

Improver Corp & Ors v Remington Consumer Products Ltd & Ors [1990] FSR 181, HC (folld)

Iradar Sdn Bhd v Nutech Company Limited & Anor [2016] MLJU 1248; [2017] 1 MLRH 15, HC (refd)

Kingtime International Ltd & Anor v Petrofac E&C Sdn Bhd [2018] MLJU 1840, HC (refd)

Lim Choong Huat & Ors v Syntlz Enterprise Sdn Bhd & Ors [2010] 1 CLJ 860, HC (refd)

Merck Sharp & Dohme Corp & Anor v Hovid Bhd [2017] MLJU 77, HC (refd)

Merck Sharp & Dohme Corp & Anor v Hovid Bhd [2019] MLJU 34,CA (refd)

Meyers Taylor Pty Ltd v Vicarr Industries Ltd & Ors (1976-1977) 137 CLR 228, HC (refd)

Palm Oil Research And Development Board Malaysia & Anor v Premium Vegetable Oils Sdn Bhd & another appeal [2005] 3 MLJ 97; [2004] 2 CLJ 265, FC (refd)

SKB Shutters Manufacturing Sdn Bhd v Seng Kong Shutter Industries Sdn Bhd & Anor [2015] 6 MLJ 293, FC (refd)

Seng Kong Shutter Industries Sdn Bhd & Anor v SKB Shutters Manufacturing Sdn Bhd [2014] 5 MLJ 98, CA (refd)

Smithkline Beecham PLC's (Paroxetine Methanesulfonate) Patent [2006] RPC 10, HL (refd)

Spind Malaysia Sdn Bhd v Justrade Marketing Sdn Bhd & Ors [2018] 4 MLJ 34, FC (refd)

Windsurfing International Inc v Tabur Marine (Great Britain) Ltd [1985] RPC 59, CA (folld)

A *Yeohata Machineries Sdn Bhd & Anor v Coil Master Sdn Bhd & Ors* [2015] 6 MLJ 810, CA (refd)

Legislation referred to

B Evidence Act 1950 ss 17A, 45(1), 103
Interpretation Acts 1948 and 1967 ss 2(1)(a), 17(a), Part 1
Patent Act [CAN] s 2
Patents Act [SG]
Patents Act 1949 [UK] s 101(1)
C Patents Act 1970 [IND] s 2(1)(j)
Patents Act 1977 [UK]
Patents Act 1983 ss 3, 11, 12(1), 13(1), 13(1)(a), (1)(b), (1)(c), (1)(d), 14(1), (2)(a), 15, 15(1), 16, 23, 27A, 27A(1), 33A(1), 36(1)(a), (2), (3)(a)(i), 56, 56(1), (2), (2)(a), 58
D Patents Act 1990 [AUS] s 3, Schedule 1
Patents Act 2013 [NZ]
Patents Regulations 1986 regs 5(1)(b), 12(1)(c), (1)(f), 13(1)

Steven Cheok Hou Cher (Ng Kim Poh & Nicole Alexandra Chong Zhi Wan with him) (Christopher & Lee Ong) for the plaintiffs.
E *Mohd Aimi Zaini bin Mohd Azhar (Zainuritha-Alfa bt Abu Hassan with him) (Aimi, Zainuritha & Co) for the defendants.*

Wong Kian Kheong J:

F A. BACKGROUND

[1] This case raises a novel question of whether an instant (ready-to-wear and pinless) 'hijab' (headscarf) is patentable under Patents Act 1983 ('the PA').

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[2] The four plaintiffs ('the plaintiffs') are co-owners of Patent No MY-153705-A ('Patent 705').

[3] The first defendant company ('the first defendant') is a Malaysian
H company in the business of, among others, import and export of textiles. The second and third defendants ('the second and third defendants) are the directors and shareholders of the first defendant.

[4] The second defendant is the first defendant's husband. The second
I defendant is a sole proprietor of a business, 'Idaman Trading' ('Idaman'), which, among others, distributes and sells clothes and textiles.

[5] This action, filed by the plaintiffs, alleges that the defendants have infringed Patent 705 ('original action') by distributing and selling 'Product

Hyat' hijabs ('Hyat hijabs'). The defendants have counterclaimed to invalidate Patent 705 ('counterclaim'). A

B. ISSUES

[6] The following questions are to be decided in this case: B

(a) regarding Patent 705, who is the notional person ordinarily skilled in the art ('POSITA')?

(b) whether Patent 705 can be invalidated on any one or more of the following grounds: C

(i) is the plaintiffs' ready-to-wear and pinless hijab ('Bokitta Hijab') an 'invention' under s 12(1) of the PA?

(ii) whether Bokitta Hijab is 'new' within the meaning of s 14(1) of the PA; D

(iii) does Bokitta Hijab involve an 'inventive step' as understood in s 15(1) of the PA? and

(iv) whether Patent 705 has complied with s 23 of the PA read with regs 12(1)(c), (1)(f) and 13(1) of the Patents Regulations 1986 ('the PR'); and E

(c) if Patent 705 is valid, whether the defendants' sales of Hyat hijabs have infringed Patent 705 under ss 36(1)(a), (2), (3)(a)(i) and 58 of the PA.

C. PATENT 705 F

[7] The five 'claims' in Patent 705 ('five claims') provide as follows:

CLAIMS

1. A ready-to-wear headscarf (100) consisting of a garment element (101) made out of a pieces of fabric material, the garment element (101) comprising: a head portion that covers a user's head, the head portion having a first side, a second side, a top section, a front side and a back side, the head portion containing a face opening at the front side, a neck portion encircling a user's neck, a neck opening located at the bottom of the neck portion, the neck opening is larger in size than the face opening; a series of stitched seams comprising a front seam, a back seam, and a central seam, the front seam extending along the front side of the head portion from a first end at a bottom of the face opening and intersecting a periphery of the face opening continuing upwardly along the first side to the top section of the head portion and then downwardly to an upper region of the second side of the head portion, the front seam is offset from the face opening periphery as it extends from the first side to the top section along to the second side, the central seam extends from the front seam at the second side across the upper region of the head portion to the G H I

back side of the head portion, the back seam extends from the central seam diagonally from the back side at the top section to the a lower portion of the back side adjacent to the neck portion; and the series of stitched seams form the garment element from a planar layer of fabric to the headscarf with overlapping fabric regions adjacent the series of stitched seams (Claim 1).

2. The headscarf according to Claim 1 wherein said garment element is comprised of one or plurality of panels sewed to create the said garment element (Claim 2).

3. The headscarf according to Claim 1 wherein the garment element is an ordinary scarf (Claim 3).

4. The headscarf according to Claim 1 wherein the garment element is a custom cut scarf (Claim 4).

5. The headscarf according to Claim 1 combined with a styling accessory element (Claim 5).

D. THE PLAINTIFFS' CASE

[8] The second plaintiff ('second plaintiff') and Puan Sharifah Mazwari bt Syed Mohd Bakar ('SP2') testified for the plaintiffs.

[9] The second plaintiff testified as follows, among others:

(1) the second plaintiff is a fashion designer by profession. She is the 'Research and Development' director of a Lebanese company, Bokitta Offshore SAL ('Bokitta Co'). Bokitta Co is set up by the plaintiffs to manufacture, market and trade in fashion apparels and accessories;

(2) the second plaintiff is one of the co-designers of Bokitta Hijab and a co-inventor of Patent 705. According to her, Patent 705 solves the following three problems associated with 'traditional' hijabs ('three problems'):

(a) it takes a long time to wrap and fix a traditional headscarf in a proper and consistent shape or formed style;

(b) the amount of fabric required to wrap a traditional headscarf around the neck and head can be a lot and this may cause discomfort to the wearer; and

(c) it is difficult to wrap a scarf around the head and keep it in place without the use of pins. Pins may fall down or get lost. Pins may cause injuries to the wearer and damage the headscarf itself. Pins may also be unsafe for women carrying children;

(3) Bokitta Hijab is made ready-to-wear in a pre-wrapped state and does not require any pin to hold it in place. It can be worn easily by any person,

children or adult, in less than one minute, without any assistance, and has a consistent shape. Bokitta Hijab comes in a plurality of formed styles, fits and sizes;

(4) the plaintiffs through Bokitta Co, manufacture Bokitta Hijabs, market and sell them worldwide, including Malaysia;

(5) the first defendant used to be a customer of the plaintiffs' local distributor, 'BokittaAsia', and had purchased Bokitta Hijabs from BokittaAsia. On or around mid-2016, Bokitta Co had been notified by its Malaysian distributors that various third parties had been selling counterfeit Bokitta Hijabs. The plaintiffs then investigated this matter and discovered that the first defendant had created a 'closed' Facebook Group with the name 'Hyat hijab' ('Hyat FB page'). Access to Hyat FB page requires approval of the administrator of Hyat FB page;

(6) the plaintiffs arranged for a 'trap purchase' where the plaintiffs purchased Hyat hijab (first Hyat hijab). The first Hyat hijab was delivered by Idaman to the plaintiffs. The plaintiffs claim that the sale of the first Hyat hijab by the defendants has infringed Patent 705;

(7) around August 2016, the second and third defendants have incorporated the first defendant. The first defendant sells Hyat hijabs through its closed Facebook page and website. The first defendant operates from its premises at no 33, Jalan Budiman 2/3, Taman Putra Budiman, 43200 Seri Kembangan, Selangor (first defendant's premises); and

(8) the plaintiffs caused a second trap purchase of a Hyat hijab from the first defendant's premises (second Hyat hijab). The plaintiffs' purchase of the second Hyat hijab is evidenced by a receipt issued by the first defendant. The prices of Hyat hijabs are about 30 to 40% lower than the plaintiffs' Hijabs. The plaintiffs' business in Malaysia regarding the plaintiffs Hijabs has suffered 'grave losses' due to sales of Hyat hijabs.

[10] SP2 is called as a POSITA regarding Patent 705. I will discuss SP2's expert evidence later in this judgment.

E. CASE FOR THE DEFENDANTS

[11] The second and third defendants gave evidence for themselves as well as for the first defendant. The defendants called Puan Norunnuha bt Datuk Hj Nawawi ('SD1') as a POSITA in this case. I will discuss SD1's expert opinion together with the expert view of SP2.

[12] The first defendant testified as follows, among others:

(a) the first defendant assisted the second defendant in the distribution and sales of Hyat products;

(b) Hyat FB page was started by one Puan Haslina bt Husaini who invited the first defendant to join. Hyat FB page was not intended to sell Hyat products;

(c) the first defendant admitted that she had purchased Bokitta Hijabs. She also admitted that she had received a demand from BokittaAsia through 'FB Messenger' ('plaintiffs' demand') and after discussion with the second defendant, she had apologised to BokittaAsia and admitted the plaintiffs' demand (third defendant's admission). The first defendant alleged that when the first defendant's admission was made, the second and third defendants did not understand concepts of copyright and patent. After referring the plaintiffs' demand to the defendants' solicitors, the second and third defendants realised that the concept of 'ready-to-wear and pinless' hijabs and technical features of patents are different; and

(d) the second and third defendants deny copying Bokitta Hijabs. The first defendant claims that Hyat hijabs are different from Bokitta Hijabs with regard to the way the cloth is cut and the manner the seams are stitched together.

[13] The second defendant is a tailor since 14 years old. According to the second defendant, among others:

(a) the second defendant commenced production and sales of hijabs since 2015. The the second defendant also produces custom-made clothes for customers; and

(b) the second defendant mends, among others, Bokitta Hijabs. The first defendant and her friends always complain to the second defendant that Bokitta Hijabs are uncomfortable and are not 'tidy' (kemas). Hence, the need for the second defendant to mend Bokitta Hijabs.

F. COUNTERCLAIM SHOULD BE DECIDED BEFORE ORIGINAL ACTION

[14] I reproduce below the relevant part of s 56 of the PA:

> 56 Invalidation of patent
>
> (1) *Any aggrieved person may institute Court proceedings against the owner of the patent for the invalidation of the patent.*
>
> (2) *The Court shall invalidate the patent if the person requesting the invalidation —proves*

(a) *that what is claimed as an invention in the patent is not an invention within the meaning of section 12 or is excluded from protection under section 13* or subsection 31 (1) *or is not patentable because it does not comply with the requirements of sections 11, 14, 15 and 16*;

(b) *that the description or the claim does not comply with the requirements of section 23*; ... (Emphasis added.)

[15] For the plaintiffs to succeed in the original action that the defendants have infringed Patent 705, Patent 705 must first be valid — please see the judgment of the Federal Court delivered by Raus Sharif CJ in *Spind Malaysia Sdn Bhd v Justrade Marketing Sdn Bhd & Ors* [2018] 4 MLJ 34, at paras [144]–[145]. As such, I will first decide the counterclaim. If Patent 705 is invalidated by way of the counterclaim, the original action must be consequentially dismissed.

[16] In the original action, the plaintiffs have applied for relief against the defendants for infringement of Patent 705. As such, the defendants are 'aggrieved' by Patent 705 within the meaning of s 56(1) of the PA and are entitled to file the counterclaim — please see *Iradar Sdn Bhd v Nutech Company Limited & Anor* [2016] MLJU 1248; [2017] 1 MLRH 15, at para [13(4)(c)]. The decision in *Iradar* has been affirmed by the Court of Appeal.

[17] According to s 33A(1) of the PA, among others, the Register of Patents shall be prima facie evidence of all matters required by PA to be entered therein. As such, in view of the registration of Patent 705 under PA, the defendants have the burden to satisfy the court that Patent 705 should be invalidated under s 56(2) of the PA — please see *Merck Sharp & Dohme Corp & Anor v Hovid Bhd* [2017] MLJU 77 at para [40]. Furthermore, according to s 103 of the Evidence Act 1950 ('the EA'), the defendants who allege a particular fact that Patent 705 is invalid, have the onus to prove such a particular fact.

G. POSITA

G(1) Significance of POSITA

[18] In *Kingtime International Ltd & Anor v Petrofac E&C Sdn Bhd* [2018] MLJU 1840 at paras[28]–[30], I have followed two Federal Court judgments in *SKB Shutters Manufacturing Sdn Bhd v Seng Kong Shutter Industries Sdn Bhd & Anor* [2015] 6 MLJ 293 at paras [38]–[39] and [41] (judgment by Zulkefli CJ (Malaya) (as he then was)) and *Spind* at paras [85]–[86] regarding the importance of a POSITA:

[29] *Based on SKB Shutters Manufacturing and Spind —*

(1) *the Court may be assisted by a POSITA's expert evidence; and*

(2) *the Court is not bound to accept a POSITA's opinion*.

[30] *The POSITA's expert view is important in the following matters*:

(1) *the construction of a patent, especially its claims*;

(2) *whether a patent has made sufficient disclosure under regs. 5, 12, 13, 15 and 16 PR read with s 23 PA*;

(3) *whether an invention in a patent is novel and has not been anticipated by prior art under ss 11, 14(1) and (2)(a) PA*;

(4) *whether an invention in a patent involves an inventive step which is not obvious to a POSITA within the meaning of ss 11 and 15 PA*; and

(5) *whether a claim in a patent has been infringed under s 58 read with s 36 PA*. (Emphasis added.)

G(2) Who is POSITA regarding Patent 705?

[19] As to who is a POSITA, it is decided in *Merck Sharp & Dohme Corp* at para [60], as follows:

[60] *I am of the following view regarding a POSITA*:

(1) *a POSITA is a* —

(a) *notional person*; or

(b) *hypothetical group of persons* (please see *Rockwater*) — *who is or are ordinarily skilled in respect of the patented invention* (please see Ramly Ali JCA's (as he then was) judgment in the Court of Appeal case of *Ranbaxy (M) Sdn Bhd v Ei Du Pont De Nemours & Co* [2012] 4 MLJ 34, at paras 29–36).

In the House of Lords case of Catnic Components Ltd & Anor v Hill & Smith Ltd [1982] RPC 183 at pp 242–243, *Lord Diplock held that a POSITA should have a practical interest, knowledge and experience in the invention in question* ...

(2) *a POSITA has the common general knowledge which existed on the priority date of the patented invention* (please see *Ranbaxy* and *Rockwater*);

(3) *a POSITA is generally unimaginative and does not have any inventive capacity* (please see *Rockwater*);

(4) *a POSITA may possess common prejudices or conservatism regarding the patented invention which existed on the priority date of the patent* (please see *Rockwater*); ... (Emphasis added.)

The above High Court's decision has been affirmed by the Court of Appeal in a judgment delivered by Abang Iskandar JCA (as he then was), *Merck Sharp & Dohme Corp & Anor v Hovid Bhd* [2019] MLJU 34.

[20] Patent 705 concerns an invention regarding ready-to-wear and pinless hijabs. Based on the relevant cases applied in *Merck Sharp & Dohme Corp*, I am of the view that a POSITA for Patent 705 is a notional person who:

(a) is ordinarily skilled with regard to hijabs, including ready-to-wear and pinless hijabs; and

(b) should have qualification, knowledge and/or experience in the fashion industry pertaining to hijabs, especially ready-to-wear and pinless hijabs.

[21] I find as a fact that SP2 is a POSITA with respect to the invention regarding hijabs (including ready-to-wear and pinless hijabs) in Patent 705. This finding is based on the following evidence and reasons:

(a) SP2 has a Bachelor of Arts (Honours) degree (in Fashion Design Womenswear) and a Diploma (in Foundation Studies in Art and Design). Both these qualifications have been obtained from Central Saint Martins College of Fine Arts and Design, University of the Arts, London, United Kingdom (UK);

(b) SP2 is presently the Head of Fashion Design and Senior Lecturer in SAITO University College, Petaling Jaya where she teaches, among others, the following subjects for Degree and Diploma programs:

(i) Fashion Research, Design and Technology;

(ii) Fashion Drawing and Illustration;

(iii) Textile Studies and Application;

(iv) History of Costume and Fashion; and

(v) Fashion Marketing and Merchandising;

(c) SP2 started teaching fashion and design since 2000. She has previously taught fashion and design in the following institutions:

(i) Limkokwing University Cyberjaya Malaysia;

(ii) Raffles College of Higher Education, Kuala Lumpur (KL);

(iii) KDU College, Penang;

(iv) Equator Academy of Arts & Design, Penang; and

(v) Center of Advanced Design College, KL; and

(d) SP2 works as a fashion designer and consultant in various projects, including:

(i) 'Air Asia Runway Ready RTW Design Competition';

(ii) 'RTW Design Consultation for Modesty Wear' by Tresis Sdn Bhd; and

(iii) 'Reimagining the Malaysian School Uniform Competition' by Outpost Uniform Sdn Bhd.

[22] I am not able to accept SD1 as a POSITA regarding the invention of ready-to-wear and pinless hijabs in Patent 705 because:

(a) SD1 has no qualification in the field of fashion design; and

(b) SD1 is not a fashion designer and has no working experience in the fashion industry regarding hijabs. In fact, SD1 is, among others, a practising registered agent for patent, trade mark and industrial design.

[23] The plaintiffs' learned counsel, Mr. Steven Cheok Hou Cher, has submitted that as SD1 is not a POSITA regarding Patent 705, all the evidence of SD1 is not admissible under s 45(1) of the EA. I am of the view that if an expert witness ('X') is not accepted as a POSITA regarding a patented invention, X's evidence is still admissible but the court does not attach any weight to X's evidence. This is because s 45(1) of the EA only provides for relevancy and not admissibility of evidence. Section 45(1) of the EA provides as follows:

> 45 *Opinions of experts*
>
> (1) *When the court has to form an opinion upon a point of* foreign law or of *science or art*, or as to identity or genuineness of handwriting or finger impressions, *the opinions upon that point of persons specially skilled* in that foreign law, *science or art*, or in questions as to identity or genuineness of handwriting or finger impressions, *are relevant facts*. (Emphasis added.)

[24] I attach weight to SP2's expert testimony because she is a POSITA for Patent 705 (please see the above para 21). As SD1 is not a POSITA for Patent 705 (please the above para 22), I do not attach any weight to SD1's expert opinion.

[25] The second plaintiff is a co-inventor of ready-to-wear and pinless Bokitta Hijab in Patent 705. Accordingly, I cannot accept the second plaintiff's view on Patent 705. It is decided in *Kingtime International*, at para [40(6)(c)], as follows:

> [40(6)] *the Court shall construe a Claim in a purposive (not literal) manner as understood by a POSITA — Spind*, in paragraph 123. *In this regard —*
>
> ...
>
> (b) *the Court cannot consider the subjective opinion, intention and purpose of the inventor, patentee or author of the patent documents — please see Azahar Mohamed J's judgment (as he then was) in the High Court case of Kendek Industry Sdn Bhd v Ecotherm (TFT) Sdn BHd* [2010] MLJU 333; [2010] 10 CLJ 219, at para 44.

Accordingly, I cannot consider the opinions of SP3 and SP4 (two of the three Co-Inventors) in construing the 3 Claims; (Emphasis added.)

[26] I am unable to accept the second defendant's opinion regarding Patent 705 because as a co-defendant in this case, the second defendant is not a POSITA for the purposes of Patent 705. Furthermore, the second defendant is not an impartial witness in this case.

H. IS BOKITTA HIJAB A PATENTABLE 'INVENTION'?

[27] I reproduce below the relevant parts of ss 11, 12(1) and 13(1) of the PA:

11 *Patentable inventions.*

An invention is patentable if it is new, involves an inventive step and is industrially applicable.

12 *Meaning of 'invention'.*

(1) *An invention means an idea of an inventor which permits in practice the solution to a specific problem in the field of technology*.

...

13 Non-patentable inventions.

(1) *Notwithstanding the fact that they may be inventions within*

the meaning of section 12, the following shall not be patentable:

(a) discoveries, scientific theories and mathematical methods;

(b) plant or animal varieties or essentially biological processes for the production of plants or animals, other than man-made living micro-organisms, micro-biological processes and the products of such micro-organism processes;

(c) schemes, rules or methods for doing business, performing purely mental acts or playing games;

(d) methods for the treatment of human or animal body by surgery or therapy, and diagnostic methods practised on the human or animal body:

Provided that this paragraph shall not apply to products used in any such methods. (Emphasis added.)

[28] The defendants' learned counsel, Dato' Mohd Aimi Zaini bin Mohd Azhar, has contended that the plaintiffs' invention regarding Bokitta Hijab is not patentable under ss 11 and 12(1) of the PA. Reliance has been placed on the High Court's judgment by Hamid Sultan Abu Backer JC (as he then was) in *Lim Choong Huat & Ors v Syntlz Enterprise Sdn Bhd & Ors* [2010] 1 CLJ 860.

[29] *Lim Choon Huat* concerns a patent regarding an electronic baby cradle. I am not able to find any previous case in Malaysia or other countries which has decided on the patentability of a ready-to-wear and pinless hijab.

[30] Firstly, it is clear that the patentability of a ready-to-wear and pinless hijab is not barred by s 13(1)(a)–(1)(d) of the PA.

[31] The next question is whether a ready-to-wear and pinless hijab is an invention' (an idea of an inventor which permits in practice the solution to a specific problem in the field of technology) as provided in s 12(1) of the PA.

[32] The definition of 'invention' in our s 12(1) of the PA is different from the following foreign legislation:

(a) s 101(1) of UK's previous Patents Act 1949 (PA 1949 (UK)) defines an 'invention' as 'any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies and any new method or process of testing applicable to the improvement or control of manufacture, and includes an alleged invention'. PA 1949 (UK) has now been repealed by the present UK's Patents Act 1977 ('the PA 1977 (UK)'). The definition of 'invention' in s 101(1) of the PA 1949 (UK) is not repeated in the PA 1977 (UK). In fact, there is no definition of an 'invention' in the PA 1977 (UK);

(b) the definition of 'invention' in s 101(1) of the PA 1949 (UK) is similar to (but not identical) the meaning of 'invention' as provided in s 3 read with Schedule 1 to the Patents Act 1990 of Australia;

(c) s 2(1)(j) of the Indian Patents Act 1970 defines an 'invention' as a 'new product or process involving an inventive step and capable of industrial application'; and

(d) s 2 of the Canada's Patent Act has defined an 'invention' as 'any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter'.

[33] The following patent legislation does not define an 'invention':

(a) Patents Act 1977 (UK);

(b) Patents Act of Singapore; and

(c) New Zealand's Patents Act 2013.

[34] The Convention on the Grant of European Patents ('EPC') does not provide a definition of 'invention'. Hence, decisions of European Patent

Office's Board of Appeal and Enlarged Board of Appeal regarding EPC do not apply to the definition of 'invention' in our s 12(1) of the PA. A

[35] My research is not able to reveal any foreign legislation which has a provision in pari materia with our s 12(1) of the PA. As such, foreign patent cases do not apply in the construction of our definition of 'invention' in s 12(1) of the PA. B

[36] In construing s 12(1) of the PA, as a case of first impression, I am of the view that a ready-to-wear and pinless hijab is an 'invention' within the literal meaning of s of the 12(1) of the PA. My opinion is premised on the following reasons: C

(a) the term 'technology' has a wide meaning according to the following reputable dictionaries: D

(i) according to 'The Shorter Oxford English Dictionary', Vol 2 (MARL-Z), at p 2253, the word 'technology' means, among others, 'A discourse or treatise on an art or arts; the scientific study of the practical or industrial arts'; E

(ii) the online 'Meriam-Webster Dictionary' states that the word 'technology' means, among others:

(1) 'the practical application of knowledge especially in a particular area'; F

(2) 'a capability given by the practical application of knowledge'; and

(3) 'the specialised aspects of a particular field of endeavour'; and

(iii) according to the online 'Collins English Dictionary', the word 'technology' means, among others, 'the total knowledge and skills available to any human society for industry, art, science, etc'. G

Based on the above wide dictionary meanings, the term 'technology' in s 12(1) of the PA encompasses ideas regarding hijabs; and H

(b) traditional hijabs have three problems as explained in the above sub-paras 9(2)(a)–(2)(c). Patent 705 (which provides for ready-to-wear and pinless Bokitta Hijabs) constitutes an 'idea' of the plaintiffs which permits in practice the solution to the three problems as understood in s 12(1) of the PA. I

[37] Additionally or alternatively, Patent 705 is an 'invention' under s 12(1) of the PA when s 12(1) of the PA is construed in a purposive manner. This decision is based on the following reasons:

(a) according to s 2(1)(a) of the Interpretation Acts 1948 and 1967 ('the IA'), Part 1 of the IA applies to of the PA (which is enacted after 18 May 1967). Section 17A (in Part 1 of IA) provides as follows:

> 17A *Regard to be had to the purpose of Act*
>
> *In the interpretation of a provision of an Act, a construction that would promote the purpose or object underlying the Act (whether that purpose or object is expressly stated in the Act or not) shall be preferred to a construction that would not promote that purpose or object*. (Emphasis added.)

Section 17A of the IA has been applied by the Federal Court in *Palm Oil Research And Development Board Malaysia & Anor v Premium Vegetable Oils Sdn Bhd & another appeal* [2005] 3 MLJ 97; [2004] 2 CLJ 265 at pp 272–276 and 298–300;

(b) the purpose of of the PA is to protect ideas of inventors which:

(i) permit in practice solutions to specific problems in the field of technology (ss 11 and 12(1) of the PA);

(ii) are new (ss 11 and 14(1) of the PA);

(iii) involve inventive steps (ss 11 and 15 of the PA); and

(iv) are industrially applicable (ss 11 and 16 of the PA).

(c) applying a purposive interpretation of s 12(1) of the PA (as mandated by s 17A of the IA), Patent 705 (regarding ready-to-wear and pinless Bokitta Hijabs) falls within the meaning of an 'invention' in s 12(1) of the PA. Such a decision supports the purpose of PA (as explained in the above sub-para (2)). If otherwise, there will be an injustice to fashion designers who have come up with ideas which permit in practice solutions to specific problems in the fashion industry but such ideas cannot be protected and exploited by those fashion designers by way of patents.

[38] Based on the reasons explained in the above paras 36–37, I find that the defendants have failed to invalidate Patent 705 pursuant to ss 56(1) and (2)(a) of the PA on the ground that Bokitta Hijab is not an 'invention' under s 12(1) of the PA.

I. WHAT WAS COMMON GENERAL KNOWLEDGE ('CGK') REGARDING PATENT 705 POSSESSED BY POSITA ON PRIORITY DATE?

[39] Patent 705 did not provide for a 'priority date' (defined in s 3 of the PA as the date prescribed by s 27A of the PA). By reason of s 27A(1) of the PA, the priority date of Patent 705 is 4 November 2009, the date of filing of the application for Patent 705 ('priority date').

[40] I find as a fact that the CGK possessed by a POSITA for Patent 705 on the priority date is CGK regarding hijabs generally. A

J. SCOPE OF PATENT 705

[41] Regarding the construction of Patent 705, I refer to *Kingtime International*, at (40(2)–(6)(a)), as follows: B

> 40(2) *the first step in patent litigation is to ascertain the scope of the Claims — Spind*, at paragraph 98;
>
> (3) *the Court may be assisted by a POSITA's expert opinion in patent construction but ultimately, it is up to the Court to interpret the patent — SKB Shutters Manufacturing and Spind*; C
>
> (4) the monopoly of an invention as conferred by a patent is defined only in the Claims [not the Abstract, Descriptions, Drawings and other specifications of the patent (Other Patent Specifications)] — please see reg 13(5) PR and Lord Russell's judgment in the House of Lords in *Electric & Musical Industries Ltd & Ors v G Kalis* [1939] RPC 23 *at p 39. Electric & Musical Industries has been followed in SKB Shutters Manufacturing (in paragraph 34) and Spind* (in para 97); D
>
> (5) *the primary objective in interpreting a Claim is to limit (not to extend) the monopoly of the invention as stated in the Claim — SKB Shutters Manufacturing* (in para 19) and *Spind* (in para 97); and E
>
> (6) *the Court shall construe a Claim in a purposive (not literal) manner as understood by a POSITA — Spind*, in para 123. *In this regard —*
>
> (a) *it is an objective exercise of how a POSITA would have understood a Claim - please see Lord Hoffmann's judgment in the House of Lords in Kirin-Amgen Inc & Ors v Hoechst Marion Roussel Ltd and other appeals* [2005] 1 All ER 667 at para 32. *Kirin-Amgen has been followed in Spind at para 123; …* (Emphasis added.) F

[42] Assisted by SP2's expert opinion as a POSITA for Patent 705, I adopt a purposive interpretation of the five claims as follows: G

(a) claim 1 refers to the following essential integers:

(i) a ready-to-wear headscarf which consists of

(ii) a garment element made out of a pieces of fabric material; H

(iii) the garment element comprising a head portion that covers a user's head, the head portion having a first side, a second side, a top section, a front side, a neck portion encircling a user's neck, a neck opening located at the bottom of the neck portion, the neck opening is larger in size than the face opening; and I

(iv) the garment comprises a series of stitched seams comprising a front seam, a back seam, and a central seam, the front seam extending along the front side of the head portion from a first end at a bottom

of the face opening and intersecting a periphery of the face opening continuing upwardly along the first side to the top section of the head portion and then downwardly to an upper region of the second side of the head portion, the front seam is offset from the face opening periphery as it extends from the first side to the top section along to the second side, the central seam extends from the front seam at the second side across the upper region of the head portion to the back side of the head portion, the back seam extends from the central seam diagonally from the back side at the top section to the a lower portion of the back side adjacent to the neck portion; and the series of stitched seams form the garment element from a planar layer of fabric to the headscarf with overlapping fabric regions adjacent the series of stitched seams (essential integers (claim 1));

(b) claim 2 consists of all the essential integers (claim 1) wherein the garment element is comprised of one or plurality of panels sewed to create the garment element;

(c) claim 3 contains all the essential integers (claim 1) and claims a headscarf according to claim 1 wherein the garment element is an ordinary scarf;

(d) claim 4 has all the essential integers (claim 1) and claims a headscarf according to claim 1 wherein the garment element is a custom cut scarf; and

(e) claim 5 claims all the essential integers (claim 1) and claims a headscarf according to claim 1 combined with a styling accessory element.

K. WHETHER INVENTION IN PATENT 705 IS 'NEW'

[43] The relevant part of s 14(1) and (2)(a) of the PA provides as follows:

14 *Novelty*

(1) *An invention is new if it is not anticipated by prior art.*

(2) *Prior art shall consist of —*

(a) *everything disclosed to the public, anywhere in the world, by written publication, by oral disclosure, by use or in any other way, prior to the priority date of the patent application claiming the invention*; ... (Emphasis added.)

[44] It is decided in *Kingtime International Ltd* at para [62], as follows:

[62] *My understanding of case law regarding the Novelty Requirement is as follows*:

(1) *in deciding whether an invention in a patent is new under ss 11 and 14(1) PA, the Court must only consider the Claim and not the Other Patent Specifications — SKB Shutters Manufacturing* (at para 34) *and Spind* (at paras 104 and 113);

...

(3) *based on the POSITA's expert opinion, the Court has to identify the prior art (before the Priority Date) regarding the invention under s 14(2)(a) of the PA* (*Prior Art*) - please see the judgment of Aziah Ali JCA (as she then was) in the Court of Appeal case of *Seng Kong Shutter Industries Sdn Bhd & Anor v SKB Shutters Manufacturing Sdn Bhd* [2014] 5 MLJ 98, at para 18. The Court of Appeal's decision in *Seng Kong Shutter Industries* has been affirmed by the Federal Court in *SKB Shutters Manufacturing*;

(4) *the relevant date for the POSITA to consider the Prior Art is the date of publication of the Prior Art (not the Priority Date)* (*Publication Date (Prior Art)*) — please see Lai Kew Chai J's judgment in the Singapore High Court in *Trek Technology (S) Pte Ltd v FE Global Electronics Pte Ltd & Ors and other suits (No 2)* [2005] 3 SLR 389 at sub-para 87(a). *This is because in deciding the Novelty Requirement regarding a particular piece of Prior Art, the POSITA cannot consider publications, information, materials, use and events after the Publication Date (Prior Art)*;

(5) *the POSITA cannot combine or 'mosaic' disparate pieces of Prior Art in determining whether the Novelty Requirement has been met. Each Prior Art document has be considered by the POSITA separately* — please see *Trek Technology, at sub-para 87(b); and*

(6) *there are two tests to decide whether an invention is novel or otherwise* —

(a) *the first test consists of the following two cumulative matters*

(b) (*1st Test*) —

(i) *whether each element of the invention in the Claim has been disclosed in a single piece of Prior Art — please see the Court of Appeal's decision in Seng Kong Shutter Industries, at paragraph 18. The Court of Appeal's judgment in Seng Kong Shutter Industries has been followed by Alizatul Khair Osman JCA (as she then was) in the Court of Appeal in See See Hau Global Sdn Bhd & Anor v Mah Sing Plastics Industries Sdn Bhd & Anor* [2017] MLJU 1098; [2018] 3 CLJ 359, at para 33; and

(ii) *whether a POSITA is able to perform the invention claimed in the patent based on the single piece of Prior Act which has disclosed all the elements of the invention — please see Lord Hoffmann's judgments in the House of Lords in Smithkline Beecham PLC's (Paroxetine Methanesulfonate) Patent [2006] RPC 10 (at para 22)* and *H Lundbeck A/S v Generics (UK) Ltd* [2008] RPC 437 (at p 443); and

(c) *the second test (second test) is the 'reverse infringement test'*. The second test has been explained by Aickin J in the High Court of Australia in *Meyers Taylor Pty Ltd v Vicarr Industries Ltd & Ors* (1976-1977) 137 CLR 228, at 235. It is noted that the High Court is the apex court in Australia. *According to the reverse infringement test, if the alleged anticipation in the Prior Art constitutes an infringement of a patent, the invention in the patent is not novel.*

The application of the 1st and 2nd Tests entails a comparison by a POSITA between the

Claims (as interpreted by the POSITA) and a single piece of Prior Art based on the Publication Date (Prior Art). (Emphasis added.)

[45] I am of the view that the invention of Bokitta Hijab in Patent 705 is novel as understood in ss 11 and 14(1) of the PA. This finding is premised on the following evidence and reasons:

(a) according to SP2's expert opinion as a POSITA for Patent 705, there is no single document before the Priority Date ('prior art') which discloses *all* the essential integers (claim 1) — please see the judgment of Aziah Ali JCA (as she then was) in the Court of Appeal case of *Seng Kong Shutter Industries Sdn Bhd & Anor v SKB Shutters Manufacturing Sdn Bhd* [2014] 5 MLJ 98 at para [18];

(b) there is no evidence that a POSITA regarding Patent 705 is able to design Bokitta Hijab (the invention claimed in Patent 705) based on the single piece of Prior Act) which has disclosed all the essential integers (claim 1) — please see Lord Hoffmann's judgment in the House of Lords in *Smithkline Beecham PLC's (Paroxetine Methanesulfonate) Patent* [2006] RPC 10 at para [22]; and

(c) applying the 'reverse infringement test', there is no proof that the Prior Art constitutes an infringement of Patent 705 — please see the decision of Aickin J in the High Court of Australia in *Meyers Taylor Pty Ltd v Vicarr Industries Ltd & Ors* (1976-1977) 137 CLR 228 at p 235.

[46] In any event, based on the evidence and reasons elaborated in the above para 45, I have no hesitation to find as a fact that the defendants have failed to discharge the onus to satisfy the court that Patent 705 should be invalidated on the ground of lack of novelty under s 56(1) and (2)(a) of the PA.

L. DOES INVENTION IN PATENT 705 INVOLVE AN 'INVENTIVE STEP'?

[47] Section 15 of the PA provides as follows:

15 *Inventive step*

An invention shall be considered as involving an inventive step if, having regard to any matter which forms part of the prior art under paragraph 14(2)(a), such inventive step would not have been obvious to a person having ordinary skill in the art. (Emphasis added.)

[48] According to *Kingtime International Ltd* at para 68:

[68] *Regarding the Inventiveness Requirement —*

(1) *the Inventiveness Requirement is distinct from the Novelty Requirement — Spind, at*

para 57. The question of inventiveness only arises when an invention is novel — Spind, at para 57; A

...

(3) *the Federal Court has decided in Spind as follows —*

(a) the four-step test laid down by Oliver LJ (as he then was) in UK's Court of Appeal in *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59 *at 73–74 (Windsurfing's test), is a 'helpful guide'. The Windsurfing's test is as follows —* B

(i) *the court shall identify the inventive concept embodied in the patent* (*1st Step*); C

(ii) *the court shall assume the mantle of the POSITA in question and impute to the POSITA the CGK on the priority date* (second step);

(iii) *the third step (third step) is that the court shall identify the differences between the prior art and the alleged invention* (*differences*); *and* D

(iv) *whether, viewed without any knowledge of the alleged invention, the differences constitute steps which would have been obvious to the POSITA or whether the differences require any degree of invention* (*fourth step*); E

(b) *regarding the fourth Step —*

(i) *its application is an objective one and a question of fact. Hence, reliance on previous cases is 'not helpful'*;

(ii) *the POSITA cannot have the benefit of hindsight*; *and* F

(iii) *the court may consider primary and secondary evidence. Primary evidence consists of a POSITA's expert testimony and the reasons for such a testimony. Secondary evidence includes contemporary events and commercial success of the alleged invention. Secondary evidence in itself is not conclusive of the 4th Step*; G

(c) *the application of Windsurfing's test is not set in stone and should not be mechanically applied. The Court must always bear in mind that the ultimate question as expressed in s 15 PA is the fourth step*; and

(d) it is 'unnecessary' to apply the reformulated *Windsurfing*'s test as explained by Jacob LJ in UK's Court of Appeal in *Pozzoli Spa v BDMO SA & Anor* [2007] FSR 37, at paras 14–23. (Emphasis added.) H

[49] Applying the *Windsurfing*'s test as explained by the Federal Court in *Spind*, I am satisfied that the invention in Patent 705 involves an inventive step within the meaning of ss 11 and 15 of the PA. The application of the four-step *Windsurfing*'s test to Patent 705 is as follows: I

(a) the inventive step regarding the invention in Patent 705 is the pre-wrapped feature of Bokitta Hijab (which is pinless and easy to wear)

which is formed by a method of stitching by way of a series of stitched seams to form the garment element from a planar layer of fabric to the headscarf with overlapping fabric regions adjacent the series of stitched seams (please see claim 1) (inventive step);

(b) the court shall assume the mantle of the POSITA and impute to the POSITA the CGK on the priority date;

(c) there is a difference between the prior art and the inventive step, namely the prior art does not have the inventive step (difference); and

(d) if the POSITA has no knowledge of the inventive step and without the benefit of hindsight:

(i) the difference would not have been obvious to the POSITA. This is clear from SP2's expert evidence which constitutes primary evidence of the inventive step; and/or

(ii) the difference would require a certain degree of invention by the POSITA.

The commercial success of Bokitta Hijab constitutes secondary evidence to support the above finding that the invention in Patent 705 involves the inventive step.

[50] In any event, as explained in the above para 49, the defendants have failed to discharge the burden under s 56(1) and (2)(a) of the PA to prove that the invention in Patent 705 lacks an inventive step as required by ss 11 and 15 of the PA.

M. IS PATENT 705 DEFECTIVE?

[51] Section 23 of the PA and regs 5(1)(b), 12(1)(c), (1)(f) and 13(1) PR state as follows:

s 23 *Requirements of application.*

Every application for the grant of a patent shall comply with the regulations as may be prescribed by the Minister under this Act.

reg 5 *Application for Grant of Patent*

(1) *An application shall contain —*

...

(b) *a description*; ...

reg 12 *Description*

(1) *The description* shall first state the title of the invention as appearing in the request and *shall —*

...

(c) *disclose the invention in such terms that it can be understood and in a manner sufficiently clear and complete for the invention to be evaluated and to be carried out by a person having ordinary skill in the art, and state any advantageous effects of the invention with reference to the background art*;

...

(f) *indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is industrially applicable and the way in which it can be made and used or, if it can only be used, the way in which it can be used*.

reg 13 *Claims*

(1) *The claims shall be clear and concise and fully supported by the description*; ... (Emphasis added.)

[52] I am of the following view:

(a) Patent 705 has a 'Detailed Description of the Preferred Embodiments' ('description') which fulfills reg 5(1)(b) of the PR;

(b) the description complies with reg 12(1)(c) of the PR because the description has disclosed the invention in Patent 705 in such terms that can be understood and in a manner sufficiently clear and complete for the invention to be evaluated and to be carried out by SP2 (the POSITA for Patent 705). This is clear from SP2's expert view;

(c) it is obvious from the description regarding the way in which the invention in Patent 705 is industrially applicable and the way in which the invention can be made and used. Hence, reg 12(1)(f) of the PR does not apply to the description — please see *Merck Sharp & Dohme Corp* at para [75(3)]; and

(d) reg 13(1) of the PR has been satisfied because the five claims are clear, concise and are fully supported by the description.

[53] In view of the reasons elaborated in the above para 52, the defendants have not succeeded to discharge the onus to invalidate Patent 705 under s 56(1) and (2)(b) of the PA.

N. IS INVENTION IN PATENT 705 'INDUSTRIALLY APPLICABLE'?

[54] The defendants did not apply to invalidate Patent 705 on the ground that Patent 705 lacks industrial application as required by ss 11 and 16 of the PA. Nonetheless, for the sake of completeness, I will discuss whether Patent 705 has complied with ss 11 and 16 of the PA.

[55] Section 16 of the PA reads as follows:

Industrial application.

An invention shall be considered industrially applicable if it can be made or used in any kind of industry. (Emphasis added.)

[56] In view of the wide meaning of 'industrially applicable' in s 16 of the PA (any kind of industry), I have no hesitation to find that the invention in Patent 705 is 'industrially applicable' under ss 11 and 16 of the PA.

O. COUNTERCLAIM SHOULD BE DISMISSED

[57] As explained in the above Parts H, K, L, M and N, Patent 705 is valid. In the circumstances, the counterclaim is dismissed with costs.

P. HAVE THE DEFENDANTS INFRINGED PATENT 705?

[58] I reproduce below the relevant parts of ss 36(1)(a), (2), (3)(a)(i) and 58 of the PA:

36 *Rights of owner of patent.*

(1) Subject and without prejudice to the other provisions of this Part, *the owner of a patent shall have the following exclusive rights in relation to the patent*:

(a) *to exploit the patented invention*; ...

(2) *No person shall do any of the acts referred to in subsection*

(1) *without the consent of the owner of the patent*.

(3) *For the purposes of this Part, 'exploitation' of a patented invention means any of the following acts in relation to a patent*:

(a) *when the patent has been granted in respect of a product*:

(i) making, importing, *offering for sale, selling* or using *the product*; ...

58 *Acts deemed to be infringement.*

Subject to subsections 37(1), (2) and (3) and section 38, *an infringement of a patent shall consist of the performance of any act referred to in subsection 36(3) in Malaysia by a person other than the owner of the patent and without the agreement of the latter in relation to a product* or a process *falling within the scope of protection of the patent*. (Emphasis added.)

[59] It is explained in *Kingtime International* at para [81], that there are three tests regarding patent infringement as follows:

[81] *My understanding of case law is that there are three tests to decide Patent Infringement Issue (3 Tests) as follows*:

(1) *the essential integers Test is explained by Lord Upjohn in the 3–2 majority judgment*

in the House of Lords' case of Rodi & Wienenberger AG v Henry Showell Ltd [1969] RPC 367, at p 391 (*Rodi's Case*), as follows:

> *To constitute infringement, the article must take each and every one of the essential integers of the claim. Non-essential integers may be omitted or replaced by mechanical equivalents.* (Emphasis added.)

Rodi's case has been followed by the Court of Appeal's judgment delivered by Vernon Ong JCA in *Yeohata Machineries Sdn Bhd & Anor v Coil Master Sdn Bhd & Ors* [2015] 6 MLJ 810 at para 15;

(2) *according to the Improver's test* [1990] FSR 181, at 189 —

> *If the issue was whether a feature embodied in an alleged infringement which fell outside the primary, literal or a contextual meaning of a descriptive word or phrase in the claim ('a variant') was nevertheless within its language as properly interpreted, the court should ask itself the following three questions*:
>
> (1) *Does the variant have a material effect upon the way the invention works? If yes, the variant is outside the claim. If no —*
>
> (2) *Would this (ie that the variant had no material effect) have been obvious at the date of publication of the patent to a reader skilled in the art. If no, the variant is outside the claim. If yes —*
>
> (3) *Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention. If yes, the variant is outside the claim*.
>
> *On the other hand, a negative answer to the last question would lead to the conclusion that the patentee was intending the word or phrase to have not a literal but a figurative meaning (the figure being a form of synecdoche or metonymy) denoting a class of things which included the variant and the literal meaning, the latter being perhaps the most perfect, best-known or striking example of the class*. (Emphasis added.)

In Cadware Sdn Bhd v Ronic Corp [2013] 6 MLJ 19, at para 24, our Court of Appeal in a judgment given by Mohd. Hishamudin JCA, has applied Improver's test; and

(3) *Actavis*' test *[2018] 1 All ER 171 at paragraph 66, is as follows* —

> [66] *In these circumstances, given the weight that has been given by courts in this jurisdiction (and indeed in some other jurisdictions) to the three 'Improver questions', I think it must be right for this court to express in our own words our reformulated version of those questions. In doing so, it is right to emphasise, as Lord Hoffmann did in Kirin-Amgen* [2005] 1 All ER 667, [2005] RPC 169 (at [52]), *that these questions are guidelines, not strict rules (as indeed the Oberlandesgericht indicated in Eli Lilly & Co v ratiopharm GmbH Case* No 6U 3039/16, *when saying that it was 'generally' true that 'three requirements must be met'). While the language of some or all of the questions may sometimes have to be adapted to apply more aptly to the specific facts of a particular case, the three reformulated questions are as follows*:
>
> (i) *Notwithstanding that it is not within the literal meaning of the relevant*

claim(s) of the patent, does the variant achieve substantially the same result in substantially the same way as the invention, ie the inventive concept revealed by the patent?

(ii) *Would it be obvious to the person skilled in the art, reading the patent at the priority date, but knowing that the variant achieves substantially the same result as the invention, that it does so in substantially the same way as the invention?*

(iii) *Would such a reader of the patent have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention?*

In order to establish infringement in a case where there is no literal infringement, a patentee would have to establish that the answer to the first two questions was 'yes' and that the answer to the third question was 'no'. (Emphasis added.)

[60] The plaintiffs have adduced as evidence the first and second Hyat hijabs (exhs P4A, P4B, P4C, P6A and P6B), the subject matter of two trap purchases. SP2, the POSITA for Patent 705 has examined the first and second Hyat hijabs. According to SP2's expert opinion, the first and second Hyat hijabs have all the essential integers (claim 1). Accordingly, the first and second Hyat hijabs have breached claim 1 based on the essential integers test — please see the Court of Appeal's judgment delivered by Vernon Ong JCA in *Yeohata Machineries Sdn Bhd & Anor v Coil Master Sdn Bhd & Ors* [2015] 6 MLJ 810 at para [15].

[61] SP2 has further opined that the first and second Hyat hijabs have breached claims 2, 3, 4 and 5.

[62] Additionally or alternatively, based on SP2's expert testimony, I am satisfied that the first and second Hyat hijabs have breached claim 1 as follows:

(a) in UK's High Court case of *Improver Corp & Ors v Remington Consumer Products Ltd & Ors* [1990] FSR 181 at p 189, Hoffmann J (as he then was) poses three questions to decide whether there has been a patent infringement ('Improver's test'). Applying *Improver*'s test, based on the expert view of SP2, I find as a fact the following:

(i) the features of Hyat hijab which are different from essential integers (claim 1), do not have a material effect on the way the invention in claim 1 works ('immaterial variants');

(ii) the immaterial variants would have been obvious to SP2 (the POSITA regarding Patent 705) on the date of publication of Patent 705; and

(iii) SP2 would not have understood from the language of claim 1 that

the plaintiffs (as co-patentees of Patent 705) intended that strict compliance with the primary meaning of claim 1 was an essential requirement of the invention in claim 1; and

(b) *Improver*'s test has been 'reformulated' by Lord Neuberger P in UK's Supreme Court in *Actavis UK Ltd & Ors v Eli Lilly and Co, and other appeals* [2018] 1 All ER 171 at para [66] ('*Actavis*' test'). An application of *Actavis*' test in this case clearly shows an infringement of Patent 705 as follows:

(i) relying on the expert testimony of SP2, Hyat hijab achieves substantially the same result in substantially the same way as the invention in claim 1, namely Hyat hijab has the same inventive concept as Bokitta Hijab;

(ii) it is obvious to SP2 (the POSITA regarding Patent 705), reading claim 1 on the priority date that Hyat hijab achieves substantially the same result as the invention in claim 1 in substantially the same way as the invention in claim 1; and

(iii) SP2 would not have concluded that the plaintiffs (as co-patentees in Patent 705) intended that strict compliance with the literal meaning of claim 1 was an essential requirement of the invention in claim 1.

[63] In view of the trap purchases concerning the first and second Hyat hijabs, I am satisfied that the plaintiffs have proven on a balance of probabilities that the defendants have sold Hyat hijabs in contravention of Patent 705 within the meaning of ss 36(1)(a), (2), (3)(a)(i) and 58 of the PA.

Q. THE COURT'S DECISION

[64] In summary:

(a) SP2 (not SD1) is a POSITA regarding Patent 705. Hence, this court attaches weight to SP2's expert view on Patent 705 and does not give any weight to SD1's expert opinion regarding Patent 705;

(b) the patentability of the invention in Patent 705 is not barred by s 13(1)(a)–(1)(d) of the PA;

(c) the invention in Patent 705:

(i) is an 'invention' according to a literal and/or purposive interpretation of s 12(1) of the PA;

(ii) is 'new' within the meaning of s 14(1) of the PA;

(iii) involves an 'inventive step' as understood in s 15(1) of the PA;

A (iv) complies with s 23 of the PA read with regs 12(1)(c) and 13(1) of the PR;

(v) is 'industrially applicable' pursuant to s 16 of the PA; and

(d) the defendants' sales of Hyat hijabs have infringed Patent 705 under
B s 36(1)(a), (2), (3)(a)(i) read with s 58 of the PA.

[65] Premised on the above evidence and reasons:

(a) the counterclaim is dismissed with costs; and

C (b) the original action is allowed with costs.

[66] I wish to place on record my gratitude to both learned counsel for their able assistance in this case.

D *Counterclaim dismissed with costs; plaintiff's action allowed with costs.*

Reported by Dzulqarnain bin Ab Fatar

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